

Application No.: 09/769,834
Reply to final Office Action of: April 24, 2006

REMARKS

This amendment is responsive to the final Office Action dated April 24, 2006. Claims 1-23 are pending and stand rejected. A notice of appeal was filed on October 24, 2006, however, Applicant is submitting a Request for Continued Consideration (RCE) with this Preliminary Amendment within the period set for submission of an Appeal Brief.

By this Preliminary Amendment, Applicant has canceled claims 5 and 15, without prejudice and has amended claims and demonstrates reasons why the claims pending here are distinct from the asserted art. In particular, the Examiner has amended independent claim 1, 7, 11, and 12, to more clearly define the inventions that are claimed here. In view of these amendments to the claims the arguments presented below, Applicant respectfully requests the Examiner to reconsider all the outstanding rejections and to withdraw them.

102 Rejections

Claims 1-4, 6, 10, 12-14, 17, 20-21, and 23 are rejected under 35 U.S.C. Section 102(e) as anticipated by L'Heureux et al. Independent claims 1, 11, and 12 are amended to recite limitations that are not met L'Heureux et al.

First, Applicant reminds the Examiner that the criteria for a rejection under 35 U.S.C. § 102 as being anticipated by a prior printed publication is firmly established.

Specifically, each and every component of a claim in question must be met by the applied printed publication. For a claim to be anticipated by a single reference under 35 U.S.C. Section 102, that reference must on its own satisfy each and every recitation in that claim. *Upsher-Smith Laboratories, Inc. v. Pamlab, L.L.C.*, 412 F.3d 1319, 1323-24 (Fed. Cir. 2005); *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 1368-69 (Fed. Cir. 2003); *Elan Pharmaceuticals, Inc. v. Mayo Foundation for Medical Education and Research*, 346 F.3d 1051, 1054 (Fed. Cir. 2003); *Rosco, Inc. v. Mirror Lite Co.*, 120 Fed. Appx. 832, 836 (Fed. Cir. 2005); *Animatics Corp. v. Quicksilver Controls, Inc.*, 102 Fed. Appx. 659, 670-71 (Fed. Cir. 2004).

Second, as urged before, the patent to L'Heureux generally describes a data formatting method for embedding diverse types of data in an email message. One type of data disclosed by L'Heureux is the data type known as x-clipmail/text. *See*, col. 9, lines 4-65 of L'Heureux. The x-clipmail/text data type identifies a segment of an email message that contains DET commands

such as those listed in FIGS. 6-9 of L'Heureux. When an email message is identified with this type of data, all data contained in that segment are interpreted as commands. As an example, the syntax SET_DATE=[NUMs] can be included in the email message to set the current calendar date on the receiving device. Significantly, the commands included in the email message are fully formed commands that are distinct from standard text, which falls within the domain of the text/plain data type.

In Applicant's claimed invention, commands that are communicated via mail messages are not fully formed commands in the particular command syntax. Rather, commands are formed through an interpretation of standard text of different parts (e.g., lines) of the email message based on the recognized reserved command word. For example, a DELETE command in the database CONTACT can be formed through an interpretation of the three lines in the body of the email message illustrated in Table 5 of Applicant's specification. As this example clearly illustrates, a command is not transmitted directly in the email message. Claim 1 recites, for example, that the command is assembled using the plurality of identifiable portions of the command in the plurality of separate parts of the email message.

For at least this reason, Applicant respectfully asserts that the teachings in L'Heureux do not anticipate Applicant's claim 1. Applicant therefore submits that claim 1 as it stands is distinct from the reference asserted by the Examiner. Independent claim 12 recites similar features as those recited by independent Claim 1. On pages 5 and 6 of the office action, the Examiner indicates that L'Heureux teaches that a NEW ADDRESS ENTRY command is formed through interpretation of standard text of different lines of email. Respectfully, claims 1 and 12 as amended, further recite that the reserved command word comprises a part of a subject portion of the email message itself, which is not taught by L'Heureux.

Finally, claims 2-4, 6, 10, 13, 14, 17, 20-21 and 23 are also distinct by virtue of the fact that they depend from either claim 1 or claim 12. Applicant respectfully request the Examiner to withdraw the rejections of these claims under 35 U.S.C. Section 102(e).

35 U.S.C. § 103 Rejections

In paragraph 10 of the office action, the Examiner has variously rejected the claims 5, 7, 11, 15-16, and 22 under 35 U.S.C. §103(a) as being unpatentable over a primary reference,

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L'Heureux (U.S. Patent No. 6,697,942), in view of a second reference, Ono (U.S. Patent No. 6,742,024).

At the outset, claims 5 and 15 are canceled, without prejudice. Applicant respectfully traverses that it would have been obvious to combine the references as the Examiner suggests and urges the Examiner to reconsider the 103 rejections in view of the following reasoning set forth below. Claims 1 and 12 are distinct from L'Heureux. Claim 11, as amended also recites that the reserved command word comprises a part of a subject portion of the email message itself, and is therefore, distinct from L'Heureux. Applicant respectfully submits that L'Heureux teaches away from using a reserved command word that comprises a part of the subject portion of the email itself. Accordingly, the Examiner suggests a combination with Ono only with the benefit of hindsight provided by the claimed inventions here. The Examiner is respectfully requested to reconsider and allow the claims as amended by this preliminary amendment.

CONCLUSION

Claims 1-4 and 6-14, and 16-23 are now pending in the present patent application. The Examiner is invited to contact Applicant's undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,

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